

ESTTA Tracking number: **ESTTA620638**

Filing date: **08/11/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	3M Company
Granted to Date of previous extension	08/10/2014
Address	2501 Hudson Road 3M Center St. Paul, MN 55144 UNITED STATES

Attorney information	Jered E. Matthyse Pirkey Barber PLLC 600 Congress Avenue, Suite 2120 Austin, TX 78701 UNITED STATES jmatthyse@pirkeybarber.com, bbarber@pirkeybarber.com, drausa@pirkeybarber.com, tmcentral@pirkeybarber.com Phone:512-322-5200
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Applicant Information

Application No	86117215	Publication date	02/11/2014
Opposition Filing Date	08/11/2014	Opposition Period Ends	08/10/2014
Applicant	3D INTERNATIONAL LLC 20724 CENTRE POINTE PKWY UNIT 1 SANTA CLARITA, CA 91350 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. First Use: 1994/09/30 First Use In Commerce: 1994/09/30

All goods and services in the class are opposed, namely: degreasing preparations not used in manufacturing processes for use on engines,tires, wheels, machinery, tools and floors; soaps and detergents for automobilefinished surfaces; carpet shampoo; carpet cleaner with deodorizer; upholstery cleaners for automobile carpeting and upholstery; preparations for cleaning, protecting and preserving vehicle surfaces, namely, vinyl tops, carpets, upholstery,magnesium wire wheels and chrome spokes; glass cleaners; gum remover; adhesive remover; tar remover; automobile interior and exterior dressings in the nature of wipe-on pastes and aerosol sprays usedfor protecting, cleaning, restoring andbeautifying rubber, vinyl, and leather surfaces; automobile wax for cleaning, glazing, sealing and shining paint, glass, metal, leather, vinyl, plastic, and wood surfaces; and general purpose cleaning, polishing, and abrasive liquids and powders

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2072005	Application Date	10/24/1996
Registration Date	06/17/1997	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1995/11/28 First Use In Commerce: 1995/11/28 preparations for cleaning, polishing, glazing, waxing, restoring or preserving finished surfaces of motorized vehicles;rubbing compound, gloss enhancer, plastic, chrome and metal polish, plastic cleaner, vinyl cleaner and restorer, tire and wheel cleaner, tire dressing for motorized vehicles		

U.S. Registration No.	2072006	Application Date	10/24/1996
Registration Date	06/17/1997	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1995/11/28 First Use In Commerce: 1995/11/28 preparations for cleaning, polishing, glazing, waxing, restoring or preserving finished surfaces of motorized vehicles;rubbing compound, gloss enhancer, plastic, chrome and metal polish, plastic cleaner, vinyl cleaner and restorer, tire and wheel cleaner, tire dressing for motorized vehicles		

U.S. Registration No.	2103462	Application Date	10/24/1996
Registration Date	10/07/1997	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1995/12/06 First Use In Commerce: 1995/12/06 chemical products used to clean, polishand recondition cars and other vehicles		

U.S. Registration No.	1214547	Application Date	04/30/1981
Registration Date	11/02/1982	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1980/11/25 First Use In Commerce: 1980/11/25		

	Chemical Products Used to Clean, Polish and Recondition Used Cars and Other Vehicles		
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U.S. Registration No.	1270473	Application Date	02/25/1983
Registration Date	03/20/1984	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 002. First use: First Use: 1983/01/18 First Use In Commerce: 1983/01/18 Undercoating for Vehicles		

U.S. Registration No.	1363965	Application Date	04/25/1985
Registration Date	10/08/1985	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1985/02/08 First Use In Commerce: 1985/02/08 ADHESIVE USED IN THE AUTOMOTIVE INDUSTRY		

U.S. Registration No.	1648184	Application Date	08/27/1990
Registration Date	06/18/1991	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 1969/02/26 First Use In Commerce: 1969/02/26 pads for removing light surface rust from and scuffing the exterior surface of vehicle bodies		

U.S. Registration No.	1959110	Application Date	06/30/1995
Registration Date	02/27/1996	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 002. First use: First Use: 1993/08/31 First Use In Commerce: 1993/08/31 coating which protects spray booth walls from paint and primer over spray for use in the automotive industry		

U.S. Registration	2021852	Application Date	08/18/1995
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No.			
Registration Date	12/10/1996	Foreign Priority Date	NONE
Word Mark	3M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 002. First use: First Use: 1987/02/28 First Use In Commerce: 1987/02/28 hand, machine, and microfinishing glazes for removing and filling swirl marks on motorized vehicles		

Attachments	75186790#TMSN.png(bytes) 73308307#TMSN.png(bytes) 73414970#TMSN.png(bytes) 73533999#TMSN.png(bytes) 74091315#TMSN.png(bytes) Notice of Opposition (3MTM451).pdf(1043466 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JEM/
Name	Jered E. Matthyse
Date	08/11/2014

In Re Serial No. 86/117,215
Filed: November 13, 2013
Mark: 3D
Published: February 11, 2014

Applicant.

Opposition No. _____

3M Company (“3M” or “Opposer”), a Delaware corporation with a principal place of business at 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55144, believes that it will be damaged by registration of the mark shown in U.S. Serial No. 86/117,215, and hereby opposes same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts that:

1. Opposer is the owner of the mark and trade name 3M (the “3M Mark”).
2. Opposer adopted and began using the 3M Mark over 100 years ago, and has continuously used the 3M Mark since that time. Over the past century, Opposer has expanded its use of the 3M Mark and presently offers thousands of products and services under the 3M Mark in a wide variety of businesses.
3. Opposer has had a long and extensive presence as a manufacturer in the automotive industry.
4. Opposer sells a number of automotive-related products under the 3M Mark through its automotive, automotive OEM, and automotive aftermarket businesses, including but not limited to

car wash soaps, spray waxes, brake cleaners, clean sand systems, glass cleaners, fuel system tune-up kits, microfiber detail cloths, adhesive removers, all purpose cleaners, tire restorers, and machine polishes.

5. Opposer promotes its automotive-related products in a number of ways, including on its websites solutions.3m.com/wps/portal/en_US/3M/Automotive, 3Mauto.com, and 3Mcollision.com. The 3M Mark appears prominently on these websites and on the packaging and labeling of such products.

6. 3M is also involved in the automotive industry through its affiliation with the National Association for Stock Car Racing, Inc. ("NASCAR"). For many years, 3M has been the sponsor of the No. 16 car in the NASCAR racing circuit. The 3M Mark is displayed prominently on the No. 16 car and used extensively in connection with 3M's NASCAR-related activities and promotions.

7. The 3M Mark is inherently distinctive and serves to identify and indicate the source of 3M's products and services to the consuming public.

8. Opposer has developed an enormous amount of goodwill in its 3M Mark. The 3M Mark is extremely well-known and respected by consumers, and represents 3M's commitment to providing high-quality products to consumers.

9. As a result of Opposer's long use and promotion of the 3M Mark, the mark has become distinctive to designate 3M, to distinguish 3M and its products from those of other companies, and to distinguish the source or origin of 3M's products. As a result of these efforts, the consuming public throughout the United States widely recognizes and associates the 3M Mark with 3M and its products.

10. As a result of Opposer's long use and promotion of the 3M Mark, Opposer has acquired valuable common law rights in the 3M Mark throughout the United States.

11. As a result of Opposer's long use and promotion of the 3M Mark, the mark has become famous.

12. In addition to its extensive common law rights, 3M owns hundreds of registrations on the Principal Register of the United States Patent and Trademark Office for the 3M Mark. 3M's registrations include, but are not limited to, the following:

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Goods</u>
3M	2,072,005	June 17, 1997	Preparations for cleaning, polishing, glazing, waxing, restoring or preserving finished surfaces of motorized vehicles; rubbing compound, gloss enhancer, plastic, chrome, and metal polish, plastic cleaner, vinyl cleaner and restorer, tire and wheel cleaner, tire dressing for motorized vehicles (Class 3)
3M	2,072,006	June 17, 1997	Preparations for cleaning, polishing, glazing, waxing, restoring or preserving finished surfaces of motorized vehicles; rubbing compound, gloss enhancer, plastic, chrome and metal polish, plastic cleaner, vinyl cleaner and restorer, tire and wheel cleaner, tire dressing for motorized vehicles (Class 3)
3M	2,103,462	October 7, 1997	Chemical products used to clean, polish and recondition cars and other vehicles (Class 1)
3M	1,214,547	November 2, 1982	Chemical products used to clean, polish and recondition used cars and other vehicles (Class 1)
3M	1,270,473	March 20, 1984	Undercoating for vehicles (Class 2)

3M	1,363,965	October 8, 1985	Adhesive used in the automotive industry (Class 2)
3M	1,648,184	June 18, 1991	Pads for removing light surface rust from and scuffing the exterior surface of vehicle bodies (Class 21)
3M	1,959,110	February 27, 1996	Coating which protects spray booth walls from paint and primer over spray for use in the automotive industry (Class 2)
3M	2,021,852	December 10, 1996	Hand, machine, and microfinishing glazes for removing and filling swirl marks on motorized vehicles (Class 2)

13. Each of the registrations listed in the above chart is valid, subsisting, and incontestable pursuant to 15 U.S.C. § 1065.

14. 3D International LLC (“Applicant”) filed U.S. Serial No. 86/117,215 (the “Application”) on November 13, 2013 for the mark 3D covering the following goods in Class 3: “degreasing preparations not used in manufacturing processes for use on engines, tires, wheels, machinery, tools and floors; soaps and detergents for automobile finished surfaces; carpet shampoo; carpet cleaner with deodorizer; upholstery cleaners for automobile carpeting and upholstery; preparations for cleaning, protecting and preserving vehicle surfaces, namely, vinyl tops, carpets, upholstery, magnesium wire wheels and chrome spokes; glass cleaners; gum remover; adhesive remover; tar remover; automobile interior and exterior dressings in the nature of wipe-on pastes and aerosol sprays used for protecting, cleaning, restoring and beautifying rubber, vinyl, and leather surfaces; automobile wax for cleaning, glazing, sealing and shining paint, glass, metal, leather, vinyl, plastic, and wood surfaces; and general purpose cleaning, polishing, and abrasive liquids and powders.”

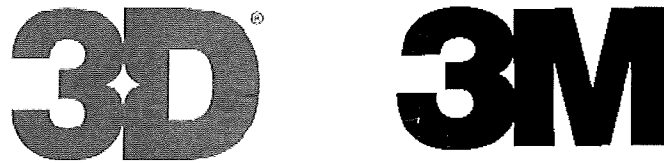
15. Applicant alleges in the Application that it first used the mark 3D in commerce on September 30, 1994.

16. Opposer has priority based on its prior use in commerce and registration of the 3M Mark in the United States.

17. Opposer's 3M Mark became famous prior to Applicant's first use of the mark 3D.

18. Applicant's mark 3D is confusingly similar to Opposer's 3M Mark in sight, sound, meaning, and overall commercial impression.

19. Further, Applicant's mark 3D, as displayed on Applicant's website at 3dproducts.com, imitates the famous 3M Mark, as shown directly below:



20. The products in the Application are the same as, or highly related to, the goods for which Opposer has used and registered the 3M Mark.

21. The goods in the Application travel in the same or similar channels of trade as Opposer's goods offered under the 3M Mark.

22. The goods in the Application are purchased and used by the same types of consumers who purchase and use Opposer's goods offered under the 3M Mark.

23. Opposer has not given Applicant permission or approval to use or register the mark 3D.

24. Applicant's mark 3D so resembles Opposer's 3M Mark as to be likely, when used on or in connection with the identified products of Applicant, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the goods Applicant offers under the mark 3D are produced, sponsored, endorsed, or approved by Opposer, or

are in some way affiliated, connected, or associated with Opposer or its 3M Mark. Registration therefore should be refused under 15 U.S.C. § 1052(d).

25. The mark 3D is also likely to cause dilution by blurring of Opposer's famous 3M Mark. Registration should there be refused under 15 U.S.C. § 1125(c).

26. Registration of the mark 3D would damage Opposer because it would confer upon Applicant statutory presumptions to which it is not entitled in view of Opposer's long-standing prior use and registration of its 3M Mark.

WHEREFORE, Opposer prays that U.S. Serial No. 86/117,215 be rejected, and that registration of the mark therein be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber PLLC, Account No. 50-3924/3MTM:451/WGB, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,



William G. Barber
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(512) 322-5200

ATTORNEYS FOR OPPOSER

Date: August 11, 2014

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION was served via first-class mail, postage prepaid, on August 11, 2014 on Applicant's correspondent of record at the following address:

Tuncer Goren
3D International LLC
20724 Centre Pointe Pkwy Unit 1
Santa Clarita, California 91350-2980

Diana A. Kausa